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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,342	12/06/2000	Benjamin Wiegand	JBP-529	9185

7590

05/07/2003

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 05/07/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/731,342

Applicant(s)

WIEGLAND ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 March 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Receipt is acknowledged of Amendment filed on March 5, 2003. Claims 1-9 and 11-20. Claim rejections as indicated in the previous Office action dated November 5, 2003 are maintained for the reasons of record.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 and 11-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 20 recite terms "antiinfective", "shaving preparations", "poison ivy products" "poison oak products" "burn products" "anti-diaper rash agents" "prickly heat agents", "sensates", and "make-up preparations", which are referred as "benefit agents". These terms are not defined in the specification, and thus the metes and bounds of the scope of the claims are unascertainable.

The remaining claims are rejected as depending on indefinite base claims.

Applicants argue that these benefit agents are any conventional actives agents used in cosmetic compositions. The specification however provides no example or explanation as to what is considered "conventional" to a skilled artisan. Whereas the specification on p. 11, lines 24-27 states that the disclosure of copending applications is incorporated in the present application, examiner notes that the recited application 09/604564 does not appear to be a copending application, and believes that there is a

typographical error in reciting 09/604563. The disclosure in that application also fails to disclose how to determine the metes and bounds of the recited terms. It is noted that another copending application 09/604449 is unavailable to examine the disclosure therein. Examiner reiterates that a skilled artisan would find the recited limitation indefinite, as the metes and bounds of the scope of the claims are unclear.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1, 2, 3, 11-17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herman. (Global Cosmetic Industry, vol. 162, n. 2, pp. 22 and 24) in view of Santora et al. (US 6046145) and Marin et al. (US 5320783).

Rejections are maintained for the reasons of record.

2. Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herman, Santora et al., and Marin et al., as applied to claims 1-3, 11-17, and 20 above, and further in view of Greenburg et al. (U.S. Pat. No. 4,940,577).

Rejections are maintained for the reasons of record.

3. Claims 1, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herman in view of Piechota (U.S. Pat. No. 5,256,396).

Rejections are maintained for the reasons of record.

***Response to Arguments***

Applicant's arguments with respect to claims 1-9 and 11-20 have been considered but are unpersuasive.

Applicants assert that the Herman, Santora, and Marin references as combined do not suggest using the Herman ringing gel to incorporate benefit cosmetic agents for topical use. Examiner respectfully disagrees. It is clear from the teaching in the Herman reference that the ringing gel is to be applied topically for cosmetic use, which necessarily delivers cosmetic agents therein to the skin. The motivation to incorporate the recited surfactants of the instant claims is suggested in the Santora reference itself, for the reference teaches that the recited ingredients are mild and nongreasy. Marin reference also provides a motivation to use the Herman ringing gel as a carrier for cosmetic ingredients.

Applicants argue that the rejection over Herman, Santora, and Marin and further in view of Greenberg fails to provide motivation to combine the references. Examiner respectfully disagrees. Greenberg teaches that the oils used in the instant invention is well known in the art for has particular advantages such non-tackiness which would have motivated a routineer to select the said oils. Examiner reiterates that Greenberg also envisioned the application of the invention in formulating ringing gel. See col. 1, lines 13-16, which teaches that 40-50 % by weight of surfactant is required to form ringing gel.

Regarding the application of the Piechota reference, applicants argue that the reference teaches away from using a composition in the form of gel prior to use. Examiner respectfully disagrees. It is well settled in patent law that patents are relevant

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as prior art for all they contain. See MPEP § 2123. The court in In re Susi held that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. See 440, F.2d 442, 169 U.S.P.Q. 423 (C.C.P.A. 1971). Examiner particularly points out that the proposition in In re Gurley that "a known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." See 27 F.3d 551, 554, 31 U.S. P.Q. 2d 1130, 1132 (Fed. Cir. 1994). In this case, while the Piechota patent is directed to a flowable liquid composition for easy transportation to containers and storage, there is no teaching against incorporating anti-acne treatment into a ringing gel for topical use or using a ringing gel as a carrier for delivering the actives to the skin. Piechota certainly prefers the flowable liquid composition for easy handling of the composition, but examiner views that such preference does not amount to a teaching away of a already known composition, i.e., a ringing gel composition used as a vehicle for an anti-acne agent.

### ***Conclusion***

No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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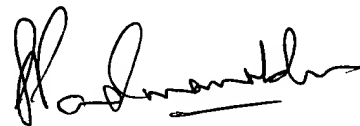
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu  
Patent Examiner  
April 22, 2003



SREENI PADMANABHAN  
PRIMARY EXAMINER

5/4/03